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EXAMINER

VARGOT, MATHIEU D

ART UNIT

PAPER NUMBER

1732

DATE MAILED: 06/05/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/496,491

Applicant(s)

GROTH et al.

Examiner

M. URBET

Group Art Unit

1732

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

☒ Responsive to communication(s) filed on 2/25/02

☒ This action is **FINAL**.

- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

☒ Claim(s) 1-8 is/are pending in the application.

Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-8 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some\* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_ ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other \_\_\_\_\_

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Hannan et al.

The applied reference discloses a process very similar to the instant and a product which anticipates the instant. Note that the patentability of product-by-process claims depends on the structure of the product, not the method by which it is made.

2. (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-5 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Delaney et al (see column 3, line 22 through column 3, line 10).

Delaney et al discloses the instant product and method of making same wherein a polyester master (col. 3, line 41) which has been embossed (see column 3, lines 27 and 50) with a hologram (col. 3, line 47) is used as a support foil for an electron beam curable material (col. 4, lines 7-10) coated

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thereon (col. 3, line 63-65), the coated material being cured and forming the instant sheet with at least one hologram being produced thereon. The polyester master is removed from the sheet.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hannan et al.

Hannan et al discloses the basic claimed process for making a sheet bearing a hologram lacking essentially a clear disclosure that the plastic or metal (see col. 7, lines 14-16) support foils or masters (80 and 90) are themselves embossed to provide the holograms which are then transferred to a thermoplastic web or sheet (12). Given that embossing to form holographic images is well known, it certainly would have been obvious to have embossed the masters of Hannan et al to facilitate formation of a long-lasting image which would be transferred to the sheet. Hannan et al teaches that the support foil/master is plastic and this would have rendered the use of thermoplastics, thermosets, polyesters and polyamides as obvious dependent on the strength characteristics desired for the master. Hannan et al unwinds the sheet 12 from a roller, but casting, extruding or coating of the sheet onto the master would have been entirely obvious dependent on the exact method used to transfer the hologram from the master to the sheet (ie, embossing a predominantly solid sheet or what constitutes a coating which solidifies into a sheet). Concerning a coated sheet, see col. 7, lines 9-13, wherein Hannan et al discloses using a Mylar

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base with a coated vinyl thereon to provide the sheet. Coatings and resins are typically cured using radiation and electron beam is a conventional mode of radiation for such curing. The exact thickness of the coated film would have been clearly within the skill level of the art.

4. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Delaney et al.

The applied reference discloses the basic claimed process lacking essentially a clear disclosure of the exact thickness of the coating film/sheet and the use of an additional adhesive layer of the instant thickness on the sheet. It is submitted that the use of an additional adhesive would have been obvious dependent on the ultimate thickness and function of the desired film and that the thicknesses of either the coating film or such adhesive layer would have been obvious for the same reasons.

5. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

In view of the amendment requiring the support foil to be removed, new art has been applied which more clearly shows this aspect. In the instant case, the support foil constitutes a mold, and the masters of Hannan et al (80 and 90) and the thermoplastic master (1) of Delaney et al are in fact molds which function as support foils. Hence, these flexible molds are support foils during the hologram transferring process.

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6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Vargot whose telephone number is 703 308-2621.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.

M. Vargot

**MATHIEU D. VARGOT  
PRIMARY EXAMINER  
GROUP 1300**

June 3, 2002